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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,260	08/14/2006	Luca Doglioni Majer	367769US91PCT	2431
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER WILLIAMS, LEZA	
			ART UNIT	PAPER NUMBER
			1789	
			NOTIFICATION DATE	DELIVERY MODE
			03/23/2012	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary****Application No.**

10/585,260

**Applicant(s)**

DOGLIONI MAJER, LUCA

**Examiner**

LELA S. WILLIAMS

**Art Unit**

1789

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 7-14 and 18-26 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 7-14 and 18-26 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-SB-03)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 9, 2011 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-14 and 18-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 7, 12, and 26 recite the limitation "water" in line 8. While the claim does state "a liquid" in line 2, there is insufficient antecedent basis for "water" in the claim.

### ***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 7, 8, 9, 10, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dogliani US 2006/0130664**.

**Regarding claims 7 and 8**, Doglioni discloses a beverage capsule for the preparation of a beverage wherein water was admitted under pressure to the inside of the capsule unto soluble product [0004]. The capsule was said to comprise a hinge portion which allowed a portion of the base to open allowing for dispensing [0027]. The hinge portion would have been “means for repeatedly increasing and decreasing the dispensing area” and it would have been obvious to one of ordinary skill in the art that the portion of the base attached to the hinge would have moved and thereby naturally increase or decrease the opening area as long as water was added to the beverage.

**Regarding claim 9**, the reference states the capsule comprises a hinge and said hinge would naturally impart oscillating movement during dispensing.

**Regarding claims 10 and 21**, as discussed above, Diglioni comprises a hinge means attached to the dispensing wall of the capsule which opens the opening area. One of ordinary skill would reasonably expect and thus find it obvious that the opening portion would have closed at least partially, once the pressure of the water was no longer applied.

**Regarding claim 26**, Doglioni discloses a beverage capsule for the preparation of a beverage wherein water was admitted under pressure to the inside of the capsule unto soluble product [0004]. The capsule was said to comprise a hinge portion which allowed a portion of the base to open allowing for dispensing [0027]. The hinge portion would have been “means for repeatedly increasing and decreasing the dispensing area” and it would have been obvious to one of ordinary skill in the art that the portion of the base attached to the hinge would have expectedly moved and thereby naturally increase or decrease the opening area as long as water was added to the beverage. Diglioni comprises a hinge means attached to the dispensing wall of

the capsule which opens the opening area. One of ordinary skill would reasonably expect and thus find it obvious that the opening portion would have closed at least partially, once the pressure of the water was no longer applied.

**7. Claims 7-13, 21, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardin et al. EP 1243210.**

**Regarding claim 7**, Bardin discloses a beverage capsule for the preparation of a beverage obtained by supplying water within the capsule (abstract) having a dispensing wall and lid portion (figure 6, item 23) which opened to discharge the liquid. The lid portion was said to open inward as a mechanical reaction force was applied from the outside [0009], thereby the capsule would have included a means for repeatedly increasing and decreasing the area of the dispensing opening. Further, it would have been obvious that cycle of increasing and decreasing the dispensing area would have repeated as long as water was added into the capsule, as it would have been expected to do so naturally. Moreover, Bardin states that the folding means was "resilient" [0009], as such once the mechanical force was no longer applied to the capsule, as the beverage was being dispensed and the pressure of the capsule decreased, the force of the beverage as it exits the capsule would have naturally caused the opened tab to move and thereby repeatedly increase and decrease the open area.

**Regarding claims 8 and 9**, given the disclosure of the folding means "is adapted to cause the opening member to fold upon action of said reaction force", meaning the folding means was acting as a joint holding the lid portion and wall portion so that the lid can swing, it

would have been considered a “hinge” [0007, 0009, 0017] and would have naturally functioned to impart an oscillating movement to the wall during the dispensing step.

**Regarding claims 10 and 21**, as discussed above; Bardin comprises a hinge means attached to the dispensing wall of the capsule. The reference discloses that once the water stops entering the capsule and the plunger separate, the capsule substantially or partially recovers to its initial dimension (col. 9, line 30-35). Given this disclosure one of ordinary skill would reasonably expect and thus find it obvious that the lid portion would have also closed at least partially, because the pressure was no longer applied and there was no outside force acting on it.

**Regarding claims 11**, Bardin is applied to claim 7 as discussed above. The reference discloses a capsule which was able to withstand the pressure of an extraction system [0021]; however the reference does not disclose the rigidity of the capsules as measured by a punch. Given Bardin’s teaching of constructing a capsule with “pressure resistant but elastically deformable material” it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule with sufficient rigidity, to withstand the pressure of the extraction system, which it was to be utilized. Furthermore, the selection of a known material based on its suitability for its intended use supports a prima facie obviousness as determined in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (see MPEP 2144.07). Therefore, it would have been obvious to one of ordinary skill in the art to use a suitable material for the use of an extraction system.

**Regarding claim 12**, Bardin discloses a beverage capsule for the preparation of a beverage obtained by supplying water within the capsule (abstract) having a dispensing wall and

lid portion (figure 6, item 23) which opened to discharge the liquid. The lid portion was said to open inward as a mechanical reaction force was applied from the outside [0009], thereby the capsule would have included a means for repeatedly increasing and decreasing the area of the dispensing opening. Further, it would have been obvious that cycle of increasing and decreasing the dispensing area would have repeated as long as water was added into the capsule, as it would have been expected to do so naturally.

The reference discloses a capsule which was able to withstand the pressure of an extraction system [0021]; however the reference does not disclose the rigidity of the capsules as measured by a punch. Given Bardin's teaching of constructing a capsule with "pressure resistant but elastically deformable material" it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule with sufficient rigidity, to withstand the pressure of the extraction system, which it was to be utilized. Furthermore, the selection of a known material based on its suitability for its intended use supports a prima facie obviousness as determined in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (see MPEP 2144.07). Therefore, it would have been obvious to one of ordinary skill in the art to use a suitable material for the use of an extraction system.

**Regarding claims 13 and 22**, Bardin is applied as discussed above. The reference discloses a capsule which has an area capable of being opened to allow fluid to pass [0009]. Although the reference does not disclose the thickness of the surrounding wall, it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule

wherein the thickness of the opening portion was greater than its surrounding walls, to withstand the force which was applied to it and not break off in the process.

**Regarding claim 26,** Bardin discloses a beverage capsule for the preparation of a beverage obtained by supplying water within the capsule (abstract) having a dispensing wall and lid portion (figure 6, item 23) which opened to discharge the liquid. The lid portion was said to open inward as a mechanical reaction force was applied from the outside [0009], thereby the capsule would have included a means for repeatedly increasing and decreasing the area of the dispensing opening. Further, it would have been obvious that cycle of increasing and decreasing the dispensing area would have repeated as long as water was added into the capsule, as it would have been expected to do so naturally.

Bardin comprises a hinge means attached to the dispensing wall of the capsule. The reference discloses that once the water stops entering the capsule and the plunger separate, the capsule substantially or partially recovers to its initial dimension (col. 9, line 30-35). Given this disclosure one of ordinary skill would reasonably expect and thus find it obvious that the lid portion would have also closed at least partially, because the pressure was no longer applied and there was no outside force acting on it.

**8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bardin et al. EP 1243210 in view of Doglioni US 2006/0130664.**

**Regarding claim 14,** Bardin is applied to claim 13 as stated above. Although figure 5 of Bardin shows a capsule which did not have a flat bottom, thereby resulting in an angle of inclination, said angle was not expressly disclosed.



Dogliani discloses means for limiting the deformation of the capsule comprising having an angle of inclination towards the base wall within the range of 1 to 15 degrees [0012-0014]. Thus, it would have been obvious to one of ordinary skill to have said angle in said range in efforts to limit deformation.

**9. Claims 18-20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardin et al. EP 1243210 in view of Hale U.S Pat. No. 6,810,788.**

**Regarding claims 18, 19, 23, 24, 25,** Bardin discloses a capsule as applied to claims 7 and 8 above. Bardin, however does not disclose a filter element. Hale discloses a beverage cartridge and filter assembly wherein the filter components were spaced apart from the bottom wall by being coupled to the sloped step about an outer edge (Fig 4, 50 & col. 3, lines 55-65). Although Hale does not disclose the outer edge to be a "spacer", the edge did function as so. Given Hale's teaching that the filter bows when in use and the bottom wall provides support for the filter (col. 5, lines 24-30), one of ordinary skill would have been motivated to not only use a filter in the invention of Bardin, but to space the filter apart from the bottom wall of the capsule to ensure the filter does not fall apart during the beverage making process.

**Regarding claim 20,** Bardin teaches that as water enters the capsule, the inside pressure starts to build and deforms the capsule outwardly [0030].

#### ***Response to Arguments***

10. Claims 7-14 and 18-26 are currently pending. Claims 1-6 and 15-17 are withdrawn.

11. Applicant's amendment filed May 9, 2011 were sufficient to overcome the 35 U.S.C §112, first paragraph rejections and claim objections of the previous office action. Therefore the rejection and objection has been withdrawn.

Regarding applicant's statement pertaining to Bardin, applicant states the reference does not disclose that the container opening "repeatedly increases and decreases in area as long as water is added to the container" and that the reference teaches away from such movement; however, although the reference does not recite the limitation verbatim, the reference does describe a capsule which would have been able to function as so. Bardin states the foldable portion was "preferably" non-recovering to the original state; however nowhere in the reference does it state that the foldable portion cannot recover or that it does not recover in part. The lid portion was said to open inward as a mechanical reaction force was applied from the outside [0009], thereby the capsule would have included a means for repeatedly increasing and decreasing the area of the dispensing opening. Further, it would have been obvious that cycle of increasing and decreasing the dispensing area would have repeated as long as water was added into the capsule, as it would have been expected to do so naturally. Bardin also states that folding means was "resilient" [0009], as such once the mechanical force was no longer applied to the capsule, as the beverage was being dispensed and the pressure of the capsule decreased, the force of the beverage as it exits the capsule would have naturally caused the opened tab to move and thereby repeatedly increase and decrease the open area. It is clear that although Bardin states the foldable portion was to remain open, it would have naturally closed, at least partially, given the force of gravity as well as the teaching of the opening being "resilient", thus creating a varying of the open area. Additionally, the following is noted:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In *re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In *re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing ..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

Regarding *Hale*, note that while *Hale* does not disclose all the features of the present claimed invention, *Hale* was used as a teaching reference, and therefore, it is not necessary for

this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely a beverage cartridge and filter assembly wherein the filter components were spaced apart from the bottom wall by being coupled to the sloped step about an outer edge (Fig 4, 50 & col. 3, lines 55-65), and in combination with the primary reference, discloses the presently claimed invention.

Regarding applicant's comments pertaining to the rigidity of the capsule, it is noted that Bardin does not expressly state the presently claimed rigidity as it relates to a punch; however, the reference discloses a capsule which was able to withstand the pressure of an extraction system [0021]. Given Bardin's teaching of constructing a capsule with "pressure resistant but elastically deformable material" it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule with sufficient rigidity, to withstand the pressure of the extraction system, with which it was to be utilized. Furthermore, the selection of a known material based on its suitability for its intended use supports a prima facie obviousness as determined in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (see MPEP 2144.07). Therefore, it would have been obvious to one of ordinary skill in the art to use a suitable material for the use of an extraction system.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LELA S. WILLIAMS whose telephone number is (571)270-1126. The examiner can normally be reached on Monday to Thursday from 7:30am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Humera Sheikh can be reached on 571-272-0604. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LELA S WILLIAMS/  
Examiner, Art Unit 1789

/Kelly Bekker/  
Primary Examiner